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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,998

06/17/2005

Jean-Marie Bernard

RN02184

1195

7590

03/17/2008

Rhodia Inc.
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EXAMINER

CAMERON, ERMA C

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

03/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,998	Applicant(s) BERNARD ET AL.	
	Examiner /Erma Cameron/	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The use of the trademarks such as CMI 1415 (14:19) has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Page 6 lines 3-11 states that imidazoles substituted in the 4 or 5 or 4,5 positions are examples of blocking agents of the claimed invention. However, these compounds would not

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meet the limitation of claims 10, 11 or 17 that require the hydrocarbon chain to be in the 2 position.

4. Claims 10-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Page 8 lines 25-26 states that an arylenedialkylene diisocyanate may be used in the claimed invention. However, this would not meet the limitation of claim 10 of an aliphatic isocyanate.

5. Claims 10-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The acronyms of the table on page 16 are not clearly defined, and therefore their meaning is not clear: HDB, HR, DMP, HDT.

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 10, 12, 13, 16, 17: it is not clear what is meant by “aromatic nature”. Is this different from “aromatic”?

b) Claims 10 and 17: “type” is vague and indefinite.

c) Claim 14: “several” has not been defined and is therefore vague.

d) Claims 10 and 17: it is not clear if the open valence on the C of the chemical structure means that the hydrocarbon chain is attached here or not.

e) Claim 14: it is not clear if the “several blocking agents” is the same or different as the “heterocycle” of claim 10 or if the blocking agent can be other than a heterocycle.

f) Claim 14: there is no antecedent basis for "blocking agent".

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g) Claim 17: it is not clear what is meant by “partially aliphatic”. How is a compound partially aliphatic?

h) Claim 18: is rejected as indefinite, because you cannot claim a coating itself, only a coating composition or a coated material. A coating is associated with the article coated. Ex parte Scott 66 USPQ 371.

Claim Objections

8. Claim 20 is objected to because of the following informalities: lacks a period.
Appropriate correction is required.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 62 - 164049.

'049 teaches making a coating with HMDI, 2-(m)ethylimidazole as blocking group, and a polyol. There may be other imidazoles as blocking agent, as well as other species of blocking agent. It appears that a combination of some of the imidazole blocking agents would result in the limitation of claim 14. The coating is dried at 70 C after application. The drying time is not given, but it would have been obvious to optimize the drying time thru no more than routine experimentation. See Abstracts and pages 5, 7 and Examples of translation.

11. Claims 10-11 and 15-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Flosbach et al (6013326).

'326 teaches a coating composition that comprises a hydroxy resin, and an isocyanate such as HMDI that may be blocked with 2-methylimidazole or other conventional blocking agents, and which is dried at 80-160 C for 20-40 minutes (see Abstract; 4:33-5:49; 7:45-8:18).

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12. Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 60 - 040121.

'121 teaches a coating composition of a polyol and HMDI blocked with 2-isopropyl or 2-n-butyl-imidazole. It would appear that a mixture would result in the limitation of claim 14. See Abstracts.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erma Cameron/
Primary Examiner
Art Unit 1792

March 8, 2008